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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/749,264

12/31/2003

Ian Legate

1865-US

8491

61574 7590 02/20/2007
LAW OFFICE OF BRUCE D. RUBENSTEIN
405 WALTHAM STREET, #404
LEXINGTON, MA 02421

EXAMINER

TO, TUAN C

ART UNIT

PAPER NUMBER

3663

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No. .

10/749,264

Applicant(s)

LEGATE ET AL.

Examiner

Tuan C. To

Art Unit

3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 9-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 9-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/5/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claim 1, the support for the limitation "a database that stores data bus information for a plurality of different types of data buses" cannot be found in the specification. In figure 2, and paragraph 0027, the vehicle data bus information includes the data protocol type. Nowhere in the specification can be found to include the teaching of "different types of data busses".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the application program" in the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 4, and 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klausner et al. (US 6748305B1) and in view of Seashore et al. (US 5916286A).

With respect to claims 1, 9, and 11-13, Klausner et al. a system/method of storing data in a vehicle and evaluating said stored data. In Klausner et al, the vehicle

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data stored in a memory, and that said data can be acquired from a vehicle data bus (Klausner et al., abstract). The method of acquiring vehicle data is responsive to the execution of a telematics application on a local telematics unit. Such the telematics unit can be seen in figure 1 of Klausner et al. They are the units (111) through (116) which are connected via the data bus (108). The telematics application such as transmitting the data over data bus system is disclosed (Klausner et al., page 6, lines 39-47).

Referring now to figure 3 of the patent, the claimed local vehicle library can be seen through the form of usage chip (101b), which includes a microprocessor (300) for data acquisition and analysis (Klausner et al, column 7, lines 7-11). In column 5, lines 8-23, Klausner et al. directs to the point "data going from these components to the data bus or data that can be retrieved from these components over the data bus", "data can be retrieved from memory 100". Therefore, Klausner et al. teaches "retrieving vehicle data bus information from a database". Also, in column 7, lines 26-35, Klausner et al. also teaches the following: "On microprocessor (300), data or information is extracted and interpreted", and that the interpreted data is also provided for the telematics application as discussed herein above.

Klausner et al. fails to disclose the following: "retrieving vehicle data bus information from a database that stores data bus information for a plurality of different makes of vehicles the retrieved vehicle data bus information being associated with the make of vehicle on which the telematics application is executed".

Seashore et al. teaches a portable automotive diagnostic tool as a local telematics unit that receives information from automotive computer of a vehicle. The

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vehicle makes are stored in the flash memory (34) (Seashore et al., figure 3; column 3, lines 9-11; column 7, lines). The flash memory stores automobile code for each vehicle type. The vehicle data regarding a type of vehicle is retrieved in according to an input from user (Seashore et al., column 8, lines 28 and 29).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Klausner et al. to include the teachings of Seashore et al. so that a mechanic is capable to retrieve a diagnostic test or a vehicle information of a service vehicle that needed to be repaired.

With regard to claim 4, Klausner et al. further teach that the telematics application includes a vehicle diagnostics application (Klausner et al, column 6, lines 39-47).

With regard to claim 10, Klausner et al. disclose that the vehicle information can be passed to a protocol driver, wherein such protocol driver is a CAN (Klausner et al., column 6, lines 39-41).

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klausner et al. (US 6748305B1), Seashore et al. (US 5916286A) as applied to claims 1 and 4, and further in view of Trsar et al. (US 20050021294A1).

Klausner et al. and Seashore et al. fails to disclose the following: "establishing a wireless link to a remote server, accessing a vehicle database with the remote server, and downloading vehicle data bus information to the local vehicle library from the remote database".

The secondary reference to Trsar et al. is directed to a diagnostics service system/method including a data processing system (100), wherein said processing system includes a communication interface (218) coupled to bus (202). Communication interface may be local area network (LAN) card, wireless links, etc (Trsar et al, paragraph 0027, lines 8-11). The communication interface (218) is provided for establishing a wireless link to the remote server (230) through the Internet (227) (Trsar et al., paragraph 0029). In addition, the communication interface (218) is configured to send and receive electrical, electromagnetic or optical signals. Therefore, the communication interface (218) associates with bus (202) to gain advantage in accessing a vehicle database (storage device 210) with the remote server, and transferring vehicle information via the bus (202) to the processing system (100) from the server (230) (Trsar et al., figure 1C; page 3, paragraph 0028).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Klausner et al. to include the teachings as taught by Trsar et al. to gain advantage therefore (i.e., an authorized person is able to diagnose a vehicle system of a motor vehicle by collecting vehicle information via wireless connection to the Internet. The required parts needed for a replacement may be easily found after making the connection to the Internet).

With regard to claim 3, Klausner et al. disclose that the vehicle information can be passed to a protocol driver, wherein such protocol driver is a CAN (Klausner et al., column 6, lines 39-41).

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While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

Response to Arguments

The applicant's request for continued examination has been fully considered. However, the application cannot be placed in a condition of allowance because the prior art still read on the limitations of the claimed invention.

Conclusions

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan C To whose telephone number is (571) 272-6985. The examiner can normally be reached on from 8:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Patent Examiner,

A handwritten signature in black ink, appearing to read 'Tuan C To', is written over a horizontal line.

Tuan C To

February 13, 2007